

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/615,705
ATTORNEY DOCKET NO. Q60098

REMARKS

Applicant herein adds new claims 21-29. New claims 21-29 are fully supported by the specification as originally filed, and add no new matter. New claims 21-29 read on the elected species, and entry and consideration of the above new claims is respectfully requested.

Applicants are concurrently filing a Request for Continued Examination with this Amendment to enter new claims 20-29.

Claims 1-18 and 20-29 are all the claims presently pending in the application.

1. Claims 3, 8, 10, 12 and 13 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicant traverses the rejection of claims 3, 8, 10, 12 and 13 for the following reasons.

The rejection of claims 3, 8, 10, 12 and 13 is premature. Claims 3, 8, 10, 12 and 13 are multiple dependent claims that depend from claims 1 and 2. Claim 1 was elected for prosecution on the merits and has been indicated as generic by the Applicant in the Response to Election of Species Requirement filed on March 21, 2001. The claims are not rendered indefinite because they depend from both elected and non-elected species. Therefore, it is unnecessary to consider the metes and bounds of claims 3, 8, 10, 12 and 13 with respect to claim 2. Claim 2 has been withdrawn from consideration, and the form of claims 3, 8, 10, 12 and 13 depending from non-elected claim 2 should simply be considered as withdrawn claims. Applicant respectfully requests that the Examiner withdraw the §112 rejection.

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2. Claims 1, 3, 8, 10, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ozaki et al. (U.S. Patent No. 4,456,939) in view of Miller (U.S. Patent No. 5,255,146). Applicant respectfully traverses the rejection of claims 1, 3, 8, 10, 12 and 13 and insofar as the rejection applies to new claims 20-29.

The Examiner acknowledges that Ozaki et al. fails to teach or suggest that the wire resistance of the ground potential wire between the ESD element connection point and the ground terminal is larger than the wire resistance of the ground potential wire between the ESD element connection point and the MOS capacitor connection point. *See* numbered paragraph 5, pages 3-4 of the Office Action dated August 15, 2001. To overcome the deficiencies of Ozaki et al., the Examiner states that the positioning of the ESD element connection point on the ground potential wire relative to the MOS capacitor connection point on the ground potential wire would be a matter of design choice within the skills of an artisan, and that computers are routinely used to design integrated circuit layouts. However, with respect to design choice, only the simple repositioning of isolated components has ever been found to be covered by the umbrella of “design choice” and not the specific arrangement of cooperative elements. *See In re Japikse*, 86 U.S.P.Q. 70 (C.C.P.A. 1950) (the repositioning of an actuating switch from one physical location to another cannot be the basis of patentability for a hydraulic press).

The Examiner cites Cohn et al. (U.S. Patent No. 5,535,134) to support the position that it is well known to use computers in the design of integrated circuit layouts. *See* numbered paragraph 8, page 6 of the Office Action dated August 15, 2001.

Cohn et al. discloses, *inter alia*, a method for the location of objects (i.e., circuit elements) with an integrated circuit layout. However, nothing in Cohn et al. teaches or suggests the positioning of an electrostatic protection element with respect to an MOS capacitor, such that the ground wire resistance between the electrostatic protection element and ground terminal connection points is larger than the ground wire resistance between the electrostatic protection element and MOS capacitor connection points, as recited in claim 1. Thus, while the Examiner takes official notice that it is conventional to use computers to assist in the design of integrated circuit layouts, nothing in either Ozaki et al. or Cohn et al. teach or suggest the resistance relationship as recited in claim 1. However, an Examiner may not rely on official or judicial notice at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. *See Ex parte Cady*, 148 U.S.P.Q. 162 (Bd. of App. 1965). As discussed above, both Ozaki et al. and Cohn et al. lack any teaching or suggestion of the resistance relationship recited in claim 1.

In addition, if the Examiner has relied on “common knowledge” or “well-known” prior art and “the applicant traverses such an assertion, the examiner should cite a reference in support of his or her position.” (MPEP § 2144.03, 2nd par.). Applicant traversed the Examiner’s reliance on “common knowledge” or “well-known” prior art in the Amendment filed on July 3, 2001. In response to Applicant’s traversal, the Examiner cited Cohn et al. at col. 1, lines 11-19 as providing support for his position. However, in the passage cited, all that Cohn et al. states is that computers can be used for the layout of objects in a semiconductor layout. Cohn et al. is silent with respect to the claimed resistance relationship recited in claim 1. Therefore, Applicant respectfully requests that the Examiner cite a reference which contains an express teaching of the missing claimed features,

and if the Examiner cannot find such an express teaching, then Applicant requests that the Examiner allow the pending claims.

As an alternative, the Examiner combines Ozaki et al. with Miller in order to overcome the acknowledged deficiencies of Ozaki et al. The combination of Ozaki et al. and Miller, however, fails to teach or suggest the invention recited in claim 1. The Examiner cites Miller, alleging incorrectly that it teaches the placement of an electrostatic protection element with respect to a ground terminal and a MOS capacitor, such that the ground wire resistance between the ground terminal and electrostatic protection element connections is greater than the ground wire resistance between the electrostatic protection element and MOS capacitor connections. Fig. 2 of Miller depicts a plurality of ESD protection circuits 14 connected between a V_{DD} ring and a V_{SS} ring.

The combination of Ozaki et al. and Miller fails to teach or suggest that the “wire resistance of said ground potential wire between said connection point on said ground potential wire and said ground terminal is larger than a wire resistance of said ground potential wire between said connection point on said ground potential wire and a connection point on said ground potential wire of said second end of said MOS capacitor” as recited in claim 1. In Fig. 2 of Miller and its accompanying text, there is no indication that the ESD protection circuit 14 is positioned relative to a MOS capacitor such that the resistive relationship as recited in claim 1 is taught or suggested. At best, Ozaki et al. and Miller are cumulative, and simply illustrate that an electrostatic protection device can be connected to a signal input (Ozaki et al.) or power source wiring (Miller). The combination of references fails to show, however, the claimed resistance relationship in a ground

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potential wire coupled between an electrostatic protection device, a capacitor and a ground terminal, as recited in claim 1.

Applicant respectfully reminds the Examiner that, in order to establish a *prima facie* case of obviousness the prior art references must teach or suggest all the claimed limitations, and the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP § 2142 (7th ed. 1998) citing *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Critically, the Examiner has not pointed to any teaching or suggestion, in the combination of Ozaki et al. and Miller, of the claimed resistance relationship in a ground potential wire coupled between an electrostatic protection device, a capacitor and a ground terminal, as recited in claim 1.

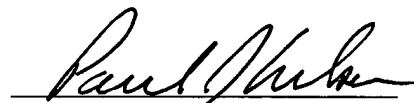
Thus, Applicant believes that claim 1 is allowable over the combination of Ozaki et al. and Miller, and Applicant further believes that claims 3, 8, 10, 12 and 13, as well as new claim 20, are allowable, at least by virtue of their dependency from claim 1.

Applicant further believes that new independent claim 21 is allowable over the combination of Ozaki et al and that new claims 22-29, are allowable, at least by virtue of their dependency from claim 21.

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Entry and consideration of this Amendment is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Paul J. Wilson", is written over a horizontal line.

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 21-29 are added as new claims.